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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/224,231 12/30/98 SALLEN

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LM02/0820

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EXAMINER

SWANN T.T.L.G

ART UNIT

PAPER NUMBER

2736

DATE MAILED:

08/20/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

<b>Office Action Summary</b>	Application No. <b>09/224,231</b>	Applicant(s) <b>Sallen et al.</b>
	Examiner <b>Glen R. Swann III</b>	Group Art Unit <b>2736</b>

Responsive to communication(s) filed on \_\_\_\_\_.

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-6 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-6 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

**--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---**

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1. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:
  - (a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or
  - (b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

2. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

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3. Claims 1-~~6~~<sup>7</sup> are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

4. Claim 5 is rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

“The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.”

Claim 5 corresponds to claims 1-13 of application S.N. 08/355,041. All of the afore-mentioned claims of application S.N. 08/355,041 were rejected under 35 U.S.C. 102 or 35 U.S.C. 103 and subsequently were deliberately canceled in favor of a claim reciting a combination of encoding and *FM modulation* and relying on this combination of features for patentability, the limitation that the modulation is FM being deleted in claim 5.

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5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glen Swann, whose telephone number is (703) 305-4384. He can normally be reached Monday through Thursday from 7:30 AM to 5:00 PM. He is also available on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, his supervisor, Jeffrey Hofsass, can be reached at (703) 305-4717.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist at (703) 305-3900.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Of faxed to:**

(703) 308-9051 (for formal communications intended for entry)

**Or:**

(703) 308-6743 (informal or draft communications -- please label  
“PROPOSED” or “DRAFT”).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington, VA, Sixth floor (Receptionist).



GLEN SWANN  
PRIMARY EXAMINER

SWANN:grs  
August 18, 1999